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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/634,692

08/05/2003

Paul Burnett

PRD-0023NP

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02/09/2006

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,692

Applicant(s)

BURNETT ET AL.

Examiner

Dr. Kailash C. Srivastava

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Your application under prosecution at the United States Patent and Trademark Office (i.e., USPTO) is assigned to Dr. Kailash C. Srivastava, in Art Unit 1655. To aid in correlating any papers for this application (i.e., USSN 10/313,643), all further correspondence regarding this application should be directed to Examiner Kailash C. Srivastava in Art Unit 1655.

Claims Status

2. Claims 1-34 are pending.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. §121:
 - Group I – Claims 1-2 drawn to a method to measure cellular physiological response via subjecting a cell suspension to electrical impulses, classified under Class 204, Subclass 157.15, for example
 - Group II – Claims 4-13, 17-18 and 21-33 drawn to a method to define biological activity of a compound, classified under Class 435, Subclass 29, for example.
 - Group III – Claims 14-16 drawn to a method to determine biological activity in an electric field with two transparent electrodes, classified under Class 435, Subclass 7.1, for example.
 - Group IV – Claim 19 drawn to a method to determine biological activity of a compound with a fluorescent optical marker, classified under Class 435, Subclass 173.1, for example.
 - Group V – Claim 20 drawn to a method to determine biological activity of a compound with voltage sensor as the detectable marker, classified under Class 436, Subclass 147, for example
 - Group VI – Claim 34 drawn to a system, classified under Class 435, Subclass 285.2, for example.

Linking Claims

4. Claim 3 links inventions in Groups II-V. Claim 3 will be examined upon election of any of the inventions in Groups II-V. The restriction requirement between the linked inventions is subject to the non-allowance of the linking claims, identified above. Upon the allowance of the linking claims, the restriction

requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. §121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131- 32 (CCPA 1971). See also MPEP §804.01.

Inventions are Independent and Distinct

5. The inventions are distinct, each from the other because of the following reasons:

Inventions in Groups I-V are unrelated to each other because each one of them is directed to different inventions that are not connected in design, components, operation and/or effect. These inventions are independent since they are not disclosed as capable of use together. They have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone (MPEP § 806.04, MPEP § 808.01). In the instant case, for example invention recited in claim encompassed in Group I is directed to a method to measure the cellular physiological response of a cell suspended in an electric field, when electrical impulses are applied to said cell, whereas invention in Group V is to determine the biological activity of a compound labeled with a voltage sensor as the detectable marker for the biological activity of said chemical compound. Similar distinctions exist between each of the groups II-V or different combinations of invention grouped in groups I-V. Therefore, the methods claimed in inventions I-V will not be practiced together.

Inventions in Group VI is related to inventions in Groups I-V as product and use thereof. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product [MPEP § 806.05(h)]. The process of determining effect of electrical stimuli to a cell may also be determined via inserting microelectrodes to a target cell and reading the signals with a signal detector (e.g., a seismometer or a voltmeter). Similarly, the system claimed is applicable to determine the electrical impulses subjected to any sample (e.g., determining the charge on a battery).

The inventions discussed above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each one of the above inventions is not coextensive, particularly with regard to

the literature search because each of the groups would require a search strategy different from the one required for the other. For e.g., invention in group IV is specific to determining biological activity of a chemical labeled with a fluorescent optical marker and would, therefore, require a different set of key words that those required to search the invention in Group V method to determine the biological activity of a compound labeled with voltage sensor as the detectable marker. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. For, e.g., invention in Group I is drawn to a method to measure cellular physiological response to electrical field stimulation, invention in Group VI to a product (i.e., an apparatus). Thus, it would be an undue burden to examine all of the above inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (Class and subclass), and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.

6. Applicants are advised that a reply to this requirement must include an identification of an invention elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of additional claims which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR §1.141. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR §1.48(b). Any amendment of inventorship must be accompanied by a petition under 37 CFR §1.48(b) and by the fee required under 37 CFR §1.17(l).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Terry McKelvey, can be reached on (571)-272-0775 Monday through Friday 8:30 A.M. to 5:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). Alternatively, status inquiries should be directed to the receptionist whose telephone number is (703) 308-0196.

Kailash C. Srivastava, Ph.D.
Patent Examiner
Art Unit 1655
(571) 272-0923



RALPH GITOMER
PRIMARY EXAMINER
GROUP 1200

February 6, 2006